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CHARLES ELMORE

IN THE

Supreme Court of the United States,

OCTOBER TERM, 1934.

No. 208.

HERBERT H. WAXHAM, DOING BUSINESS AS WAXHAM HATCHERIES,

Petitioner,

vs.

SAMUEL B. SMITH AND THE BUCKEYE INCUBATOR COMPANY,

Respondents.

PETITION FOR REHEARING.

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Comes now petitioner, Herbert H. Waxham, doing business as Waxham Hatcheries, by his counsel, and petitions this Honorable Court for a rehearing of the judgment of this Honorable Court filed the 7th day of January, 1935.

In view, particularly, of the fuller presentation in the petition for rehearing filed in No. 102 (Smith, Petitioner *vs.* Snow, *et al.*) concurrently with this, this petition will be limited very specifically to what appears to petitioner to be an inadvertent misapprehension of the Court disclosed in the opinion in this case, of the distinction to be drawn between a method which, (1) *may* be practiced or performed or carried on by utilizing *certain* means or mechanisms or apparatus, and (2) a method which constitutes the mere function or office of such means or mechanism or apparatus, and which method *can not* be carried on or performed by hand alone or by the use of any other means or mechanism or apparatus. In the first instance, where more than one thing can be employed to practice the

method, the method is of patentable nature if new, useful and rising to the dignity of invention. In the latter, it can, under no circumstances, be properly patented because the mere function of a machine may not be so monopolized by a patentee. In the case at bar it has always been petitioner's contention that the method of Claim 1 of the Smith patent here involved can not be carried on without utilizing in all substance the means and apparatus (incubator) pictured and described in the Smith patent, and that the claim is, therefore, invalid for functionality; or that the use of anything else to such ends would not constitute infringement. Such performance can certainly not be carried on by hand alone. That, if an invention, it can not be carried on by any other means or incubator, would seem to be a sound contention upon the face of the file wrapper and contents of the patent, the prior art, the very recitals of the patent itself, and the very necessities involved, and also upon the sworn testimony and admissions of Smith; and this view has always apparently been entertained by the lower courts until the instant case, whether the Smith patent has been sustained and found infringed, or not infringed.

Referring to the patent in suit (Rec. Vol. 2, p. 2), it is said (line 8, p. 1), "The improved apparatus and method *is* particularly designed" etc. (Italics ours.) The verb is singular. The subject is composite. Apparatus and method are merged together. In the same paragraph follows a definition of the method *in terms of function of apparatus.* This is more particularized—that is, the indispensable apparatus is defined more exactly, beginning at line 65, page 1 (Rec. Vol. II, p. 4), and there it is stated, *not* that the method *may* be practiced in the one preferred manner pictured and described, as a mere *example,* or by the use of *various* apparatus, but that "The *invention* comprises" (that is, *the* invention entitled as "Incubator", and above referred to as "improved apparatus and method",) comprises "a walled

chamber 2, * * *" the chamber being subdivided by parallel rows of curtains 3 and 4, whereby a central compartment or corridor 5 and side compartment 6 and 7 are employed. Then, in the same paragraph, (all as one unitary definition), the egg racks and trays are described and the repeated shifting of the trays of eggs is set forth. So that reading this matter with the paragraphs beginning respectively in lines 8 and 65, page 1 of the patent (that is, taking them together and construing them in common, and with the necessary interrelation between these parts so closely tied together in the patent, and in accordance with the rules of the interpretation of contracts) it would seem that no doubt could remain that any method involved in the disclosure of the patent is merely the function or office or performance of the incubator therein disclosed, pictured and described, and necessarily used, and nothing else.

Yet a third time in the patent's short description, the function or method and the apparatus are similarly united as *a single entity,* and nowhere in the description is there an indication that they may be considered apart from one another (Rec. Vol. II, p. 5, lines 79-96):

> "It, therefore, appears that the improved apparatus and method contemplates the application of hot air circulating in a column with such speed as to keep the temperature substantially uniform and so arranging the eggs that the fresh eggs are placed at one point in the column of air and held in a horizontal plane until they reach a predetermined stage of incubation and then put at a different point in the same column of air and kept in planes inclined to the horizontal and thereafter placed at such a point in the column of air that the forced draft of air acts to hold the eggs at a uniform temperature and to prevent them from becoming overheated and thereafter placing the eggs into final position for the hatching operation."

As before, the verb is singular with a combined predicate.

Nor can petitioner envision how that method and that means can be separated, or how any other means could be used for carrying on that method, and yet be within the contemplation of the patentee and within the disclosure which the statute required him to make for the information of the public (See *Permutit Co.* v. *Graver Co.* 284 U. S. 52, at page 58).

The lower courts have always viewed the patent as limited in the respect indicated, until the present case was decided. Whenever any other situation existed, as in *Buckeye* v. *Hillpot,* 24 Fed. [2d] 341 (C. C. A. 3), non-infringement was invariably held, and in cases in which the defendants' practices were markedly closer to that disclosed in the Smith patent than is that of petitioner. The Hillpot incubator had the "corridor" of the Smith patent but did not use the "curtains" of Smith. Petitioner's incubator uses neither the Smith "corridor" nor the Smith "curtains", (which were held previously to be ample to differentiate)[1] nor the Smith arrangement and rearrangement of eggs, which is an additional departure from what Smith discloses and indicates to be essential.

The claim, likewise, dovetails into this composite pattern of *means and method.* It states (Rec. Vol. II, p. 5, lines 120-124):

> "• • • and the units of heat will be carried from *the* eggs in the more advanced stage of incubation to those in *a* less advanced stage for the purpose specified." (Italics ours.)

It is the *greatest* heat, that is, the heat from *the* warmest eggs at *the* bottom of *the* side egg chambers that is the critical and designated heat which is to be taken up by the air current first entering the bottom zones of *the* egg chambers as such air mass subdivides and leaves the

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[1] Analyses of the Hillpot and Cooley cases in the Circuit Court of Appeals for the Third Circuit and those before the other Courts of Appeal are given in the appendix of Petitioner's main brief at page 27 *et seq.*

corridor, all in indispensable and definite sequence and definite and indispensable relative arrangement of parts, of features and of eggs. And unless the eggs are repeatedly moved downwardly so that the lowest tier is first impinged by the air-current, this action can not take place.

Where no corridor and curtains were present in an agency for performing the method, non-infringement was always the finding until the decision of the Ninth Circuit in the instant case. When a practitioner departs from this triple alignment of apparatus, method and claim, Smith provides no teaching. One must then blaze his own trail, for the patentee has taught him nothing. Robbins, petitioner's manufacturer, so did, and patented his discovery which petitioner utilizes. Robbins has obtained since the lower court decision a corrective reissue of the patent, No. 18,984, petitioner's practice thus being justified. (*Corning* v. *Burden,* 56 U. S. 252).

That in such case as that at bar, with *the* apparatus *necessarily* employed to perform the function, the claim is void for functionality, in distinction from a method situation in which manual or mechanical alternative procedure may be followed in practicing a method, we have stressed in our brief, pages 21 to 24, inclusive, citing the uniform rulings of this Court.

As indicating to petitioner's mind that Your Honors have evinced a misapprehension of the clear distinctions this Honorable Court has so often made between these two kinds of methods, one patentable and the other not patentable, we cite Your Honors' opinion in the instant case, as follows:

It is stated in the opinion (p. 1, lines 6-7) that the first claim of the Smith patent is

> "• • • for an improved apparatus and method for the incubation of eggs."

Of course, the eggs have to be hatched into live chicks or the method is without utility. To so do, to produce a

commercial result, which is the object of practicing the invention, *all* the eggs must be dealt with throughout their entire period of gestation, and Smith does this in one box or cabinet, as has been the practice in the prior art, but with separate confined chambers, and does so with all eggs positioned (pursuant to repeated adjustments and replacements) and so assembled, in a particular manner, that the sweep of an air current, strictly confined to definite channels through the chambers, withdraws the most potent heat units from oldest or warmest eggs and carries them on up the stack-like egg chambers progressively for transmission to progressively younger and cooler eggs. With no other "apparatus" can such function or "method" be associated. Your Honors, in stating the matter as quoted, put it in terms of interlocked apparatus and method, without perhaps sensing the indispensable mutuality residing in such relationship.

On page 1, lines 24-26, Your Honors further say:

> "By the use of materials in a particular manner he secured the performance of the function by a means which had never occurred in nature, • • •".

Here, again, Your Honors re-state the interrelation of materials and means in performing a function, "In a particular manner". Without the utilization of means and material as laid down in the Smith patent description and depicted in the drawing, the performance could not be carried on, in that particular manner; that is, such particular manner partakes only of the use of materials along with the means disclosed in the patent. In no other respect, we submit, could or can the "particular manner" set down by Smith be effected. The *particularity* is critical.

Again, as to these portions of the text of Your Honors' opinion, and particularly because of the tenets of this petition, we respectfully urge that Your Honors fell

into error in stating, apparently contrariwise (p. 1, lines 17-19:

> "But the function which a machine performs, here the hatching of eggs, is to be distinguished from the means by which that performance is secured."

If we be right, it necessarily follows that the next succeeding portion of Your Honors' opinion, in this same paragraph, beginning page 2, line 3, is inapposite to the situation, that is, that the rule here is that claim 1 is functional because it can not be carried on in any other manner than pictured and described in the patent.

Nor is there anything in the other claims of the patent to imply that claim 1 in issue has any other relation to the apparatus than that which we have outlined. Thus, claim 2 is in identical language with claim 1, except that it says that the current of air shall be "power driven"—which the Court's opinion has already held to be the scope of claim 1—and that that current shall be applied "in an adjacent chamber through openings into the egg chamber." Claim 3 is also alike except that it has as a limitation "applying a *vertically* directed current of heated air *in an adjacent* chamber [the corridor] to circulate in said egg chamber through upper and lower openings between said chamber."

Thus these—the only other *method* claims—are tied even more securely to details of the apparatus; while the first claim is tied to the apparatus equally as securely, as we have shown, but with the difference that, as to claim 1, the apparatus might be built lengthwise upon the ground, instead of vertically from the ground.

Claims 4 and 5 are drawn to the apparatus, whose material parts are, as shown before, implicit in the claim in suit.

Thus the patent is a coherent whole, whose structure is quite indistinguishable from what goes on inside of it when eggs are being incubated, and which the specification reiterates is "improved method and apparatus", or

"improved apparatus and method"—a single thing comprising a single definite structure and the function performed by it.

Petitioner earnestly solicits a review of the decision of this Court, with such consistent review of the decision in the companion case, No. 102, *Smith, Petitioner,* vs. *Snow et al., Respondents,* as may be required. The hatchery industry, in its ramified developments during the life of the Smith patent, has adjusted itself to the status of the long line of adjudications in incubator suits which your Honors' decision radically alters. Many manufacturers, and a host of hatcherymen eking out a living in these parlous times, now stand in apprehension as to past performances and in fear of summary injunctions at the outset of this year's hatching season, perhaps each hatcheryman with incubators filled with tens of thousands of costly eggs; and the food supply of the country would be materially affected by any forced restriction of hatching procedure.

It is petitioned that the opinions be revised in order to bring them into full consonance with the facts and the settled law. The claim construed as herein urged avoids infringement by petitioner, if found valid.

To such end it is petitioned that a rehearing be granted as Your Honors shall deem appropriate.

Respectfully submitted,

DRURY W. COOPER,
RAYMOND IVES BLAKESLEE,
ALLAN C. BAKEWELL,
Counsel for Petitioner.

I hereby certify that the foregoing petition is presented in good faith and not for delay.

DRURY W. COOPER.

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MEMORANDUM IN ANSWER
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Insofar as the petition for rehearing in this case is concerned, and the common grounds urged with *Snow* in case No. 102, the short answers to the several contentions are found in our memorandum filed in that case.

The only other ground urged in the instant case is the technical defense based upon the theory that the claim is "functional." This defense was briefed, argued, thoroughly considered and denied by this Court in the *Waxham* decision. The method of hatching eggs, derived by Smith, was a new one. Were the petitioner's premise sound, it is difficult to see how any method capable of performance by machinery could be protected.

Again, the petitioner emphasizes the revolutionary character of the Smith invention by calling attention to the widespread infringement which has been going on. It would be a strange doctrine that the rights of the patentee should be inversely proportional to the extent to which his patent has been infringed.

Respectfully submitted,

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